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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
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09/585,788 06/05/00 KADE

B RE-001

IM62/1115

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EXAMINER

TRAN LIEN, T

ART UNIT

PAPER NUMBER

1761

4

DATE MAILED:

11/15/00

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

**OFFICE ACTION SUMMARY**

☒ Responsive to communication(s) filed on 6/5/00

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

**Disposition of Claims**

☒ Claim(s) 1-7 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-7 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

**Application Papers**

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

☒ Notice of Reference Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

Art Unit: 1761

1. The reissue oath/declaration filed with this application is defective because it fails to identify at least one error which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP § 1414.
2. The reissue oath/declaration filed with this application is defective because it fails to contain a statement that all errors which are being corrected in the reissue application up to the time of filing of the oath/declaration arose without any deceptive intention on the part of the applicant. See 37 CFR 1.175 and MPEP § 1414.
3. Claims 1-7 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

✶ Claims 1-3 are rejected under 35 U.S.C. 251 as being broadened in a reissue application filed outside the two year statutory period. The claims do not include the limitation of proofing the bun portions for a third period of time of approximately three hours.

While the application contains a certificate of mailing with the date of June 1, 2000, certificate of mailing does not have any effect on the filing of the application to get a filing date. The filing date of the application is June 5, 2000 which is one day past the 2 year issue date of the patent.

Art Unit: 1761

Claims 1-7 are rejected under 35 U.S.C. 251 as being based upon new matter added to the patent for which reissue is sought. The added material which is not supported by the prior patent is as follows:

The subject matter about baking the bagels added on page 2 to line 13 of page 3 was not in the original disclosure. The amendment on lines 22-25 on page 6 was also not in the original disclosure. The subject matter on lines 2-10 and 13-16 on page 7 was also not in the original disclosure. Applicant has not pointed out the support for these amendments in the original disclosure. There is nothing in the original disclosure that would lead one of skilled in the art to the newly added subject matter.

4. The reissue specification is objected under 35USC 132 because it introduces new matter into the disclosure. No amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

The subject matter about baking the bagels added on page 2 to line 13 of page 3 was not in the original disclosure. The amendment on lines 22-25 on page 6 was also not in the original disclosure. The subject matter on lines 2-10 and 13-16 on page 7 was also not in the original disclosure.

Applicant is required to cancel the new matter in the reply to this Office action.

5. Claims 1-7 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled

Art Unit: 1761

in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The limitation of “ omitting any boiling step and omitting any partial baking step on any isolating planks on the deck of a commercial over “ was not in the original disclosure. There is no disclosure about such omission in the original disclosure. The limitation of “ deck baking said English muffin bagel “ was also not in the original disclosure. The limitation of “ a high-rise, light, English muffin bagel” was also not in the original disclosure. The limitation in steps c and d of claim 5 was not in the original disclosure and the properties of the bagel as claimed in claim 6 are not supported by the original disclosure. There is no discussion at all about the characteristics of the bagel in the original disclosure.

6. None of the claim amendments complies with rule 1.121(b). Applicant needs to begin with the patent claims and makes the necessary changes using brackets and underlining. All subject matter being added to the patent claims must be underlined and all subject matter being deleted from the patent claims must be placed between brackets. Claims added to the patent must be underlined in their entirety.

7. Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1: Line 3, “ kneadng “ should be ---kneading---. Step f is indefinite because the scope of the claim can not be determined; what would be considered as “ much greater”.

Art Unit: 1761

Claim 3 is indefinite. The body of the claim does not commensurate with the preamble. There is no recitation of steps of preparing bagel ingredients. Also, it is not stated what is being raised, or proofed or baked. In step c, the phrase "a very long proofing step" is indefinite because long is a relative term; what would be considered as very long? The terms "high-rise, ling" are also indefinite because they are relative term; there is no comparative basis.

Claim 5 basically has the same problem as claim 3. Additionally, the phrase "expanding upward well beyond standard bagel height" is indefinite because there is no comparative basis; what would be considered as "well beyond standard bagel height"?

Claim 6 is indefinite. The term "high rise" is indefinite because it is a relative term. Line 6 is indefinite because it is not known what would be considered as a height significantly greater than that of a standard bagel. The specification does not define what this height is. Line 8 has similar problem as line 6.

In claim 7, the term "high-rise" has the same problem as claim 6.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

Art Unit: 1761

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over the recipe for English muffins in the Boston Globe.

The recipe discloses the steps for making English muffins. The steps comprises mixing the ingredients to form a thick batter, letting the batter rise in a warm environment, stirring the batter down and letting it rise again. After the second rising the batter may sit for an hour or more.

Griddle baking the batter to form the muffins. The newspaper also discloses a recipe for bagel.

The sitting of the batter after the second rising is equivalent to the claimed long proofing step. As to the bagel ingredients, the claims do not define what the ingredients are; the ingredients for the muffin are very similar to the bagel as shown by both recipes for bagel and muffin. As to coating with a layer of cornmeal, it would have been obvious to one skilled in the art to do so because this is commonly done with muffin. As to the feature of the bagel in claim 6, it can no be determined how the product is different from the standard bagel because the characteristics with respect to height, partially closed navel and skin are all relative. It is also common to vary the size or baked product; for instance, there are very big bagels and there are also small bagels or bagels in between big and small. It would have been obvious to one skilled in the art to vary the size. As to the kiss marks, this does not make the bagel to be different. This

Art Unit: 1761

will inherently happen whenever any baked product is placed closed to each other during baking or proofing.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


The Joy of Cooking disclose recipes for muffin and bagel.

The Baking Science & Technology discusses about variation is proofing time.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lien Tran whose telephone number is (703) 308-1868. The examiner can normally be reached on Wed-Fri from 5:30 to 4:00. The fax phone number for the organization where this application or proceeding is assigned is (703) 30507718.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

November 1, 2000

  
**LIEN TRAN**  
**PRIMARY EXAMINER**  
*Group 1700*